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09/846,483	05/01/2001	Laurent Chambard	2000M005	7731

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

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Please find below and/or attached an Office communication concerning this application or proceeding.



**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/846,483
Filing Date: May 01, 2001
Appellant(s): CHAMBARD ET AL.

Jacob M. Levine
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 14 March 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellants' brief includes a statement that claims 1-8 and 11-16 should be considered a first group of claims that stand or fall together, and claims 10 and 17 together constitute a second group of claims that stand and fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,283,294	CLARKE	08-1981
6,114,288	FUJITSU et al	09-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 and 10-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke and Fujitsu et al, considered separately.

Clarke discloses lubricating oil compositions suitable for use in marine diesel engines comprising 60 to 85 parts by weight of lubricating oil, 15 to 30 parts by weight of a mixture of more than 50 weight % of a Group IIa metal overbased detergent and up to 50 weight % of a Group Ia metal overbased detergent and 0.2 to 5 parts by weight of an antioxidant, provided the molecular weight ratio of the overbased detergent mixture to antioxidant lies between 7.5:1 and 50:1. The lubricating oil may be an animal, vegetable, mineral oil or synthetic oil and is preferably a hydrocarbon oil such as mineral oil. See column 1, lines 17-44. Suitable overbased detergent additives include phenates, sulphonates, and salicylates. See column 1, line 67 to column 2. See especially lines 43-55 of column 2 where overbased calcium salicylate is taught. Examples of suitable antioxidants include alkylated phenols, organic amines, organic sulphur compounds and metal thiophosphates. See column 3, lines 52-54. Zinc dialkyldithiophosphate is taught as suitable. See column 4, lines 3-6. Clarke teaches that to be suitable for use in the

lubricating oil composition of this invention, the overbased detergent should have a TBN of between 175 and 500. See column 3, lines 29-32. The examiner maintains the position that the oil compositions of Clarke meet the limitations of the composition claims when the detergent component is an overbased salicylate. The examiner maintains the position that appellants' method claims of lubricating a medium speed compression-ignited (diesel) marine engine which comprises supplying the claimed oil composition to the engine are also encompassed by the disclosure of Clarke.

Fujitsu et al ["Fujitsu"] disclose lubricating oil compositions for internal combustion engines comprising a base lubricating oil, (1) a zinc dithiophosphate and (2) a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate and, optionally, (3) a friction modifier. The examples set forth in Table 2 comprise compositions with metallic detergent A, a calcium salicylate having a TBN of 150 mg KOH/g; metallic detergent B, a calcium salicylate having a TBN of 80 mg KOH/g; and metallic detergent C, a magnesium salicylate having a TBN of 340 KOH/g. See examples 1 and 2 which also comprise wear resistance agent A which is a secondary zinc dithiophosphate. The examiner maintains the position that these examples meet the limitations of the composition claims which comprise three components: (A) an oil of lubricating viscosity, (B) an oil-soluble overbased metal detergent additive consisting of one or more aromatic carboxylates, and (C) an antiwear additive. Appellants' open-ended claim language "comprising" allows for the addition of other components to the composition such as the friction modifier component of Fujitsu. Additionally, the preamble language "A trunk piston marine engine lubricating oil composition for a medium

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speed compression-ignited (diesel) marine engine..." is seen to be a statement of intended use or field of use for the composition which, thus, carries no patentable weight in the oil composition claims. The examiner is of the position that the body of the claim does not depend on the preamble for completeness but, instead, the claim limitations are able to stand alone. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Although marine diesel engines are not taught in Fujitsu, the oil compositions are taught as suitable for use as an engine oil for internal combustion engines wherein the oil exhibits excellent anti-wear properties with respect to moving valve parts in four-stroke engines (lines 5-9, column 1) and the medium-speed four-stroke marine diesel engines of the claims are an example of such an internal combustion engine.

(11) Response to Argument

Appellants argue that one of ordinary skill in the art would not be led by the disclosure of Clarke to expect that any improved performance would result from the use of a salicylate as the sole overbased detergent. Although Clarke does not prefer the salicylate metal salts over the phenate and sulphonate metal salts, Clarke still teaches salicylate metal salts as suitable detergents for the marine diesel engine lubricant composition. The examiner maintains the position that the overbased detergent additives of Clarks clearly meet the limitation of claimed component (B) which is broadly drawn to "an oil-soluble overbased metal detergent, as the sole overbased metal detergent, consisting of one or more aromatic carboxylates". The results presented in the specification on pages 11-14 demonstrating improved results for salicylate metal salts over phenates and sulphonate salts in marine diesel engines have been noted; however, it is

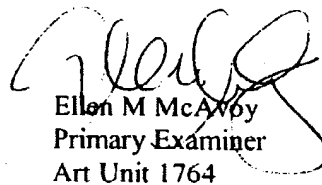
not clear if the results are unexpected to the degree needed to rebut the established *prima facie* case for the entire scope of the claims, that of *any* aromatic carboxylate compound as the detergent component and of *any* antiwear additive, not only zinc dithiophosphate as the antiwear additive. The examiner is of the position that the results presented are not commensurate in scope with the degree of protection required by the claims.


Appellants argue that there is nothing in Clarke that would lead one to exclude a dispersant and expect engine cleanliness and dispersing properties could be maintained. This is not deemed to be persuasive because Clarke does not require the addition of a dispersant; Clarke, in column 4, lines 37-38, merely teaches that "if desired, a small amount ... of a dispersant..." may be added to the composition. Appellants argue that the oil compositions set forth in Fujitsu should be assumed to contain dispersants which differs from the instant invention. This is not deemed to be persuasive because the specific examples set forth in Fujitsu in Table 2 do not include a dispersant component. Compositions with metallic detergent A, a calcium salicylate having a TBN of 150 mg KOH/g; metallic detergent B, a calcium salicylate having a TBN of 80 mg KOH/g; and metallic detergent C, a magnesium salicylate having a TBN of 340 KOH/g are set forth. Examples 1 and 2 additionally comprise wear resistance agent A which is a secondary zinc dithiophosphate. Although Fujitsu teaches in column 4, lines 50 et. seq. that the compositions may additionally contain an ash-free dispersant, an antioxidant, and other conventional additives, dispersants are not required to be present.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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EMcAvoy
July 16, 2003

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